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IN THE

Supreme Court of the United States

OCTOBER TERM, 1962

No. 313

RIPPLE SOLE CORPORATION,
Plaintiff-Petitioner,
vs.
AMERICAN BILTRITE RUBBER CO., INC.,
Defendant-Respondent

REPLY BRIEF OF PETITIONER IN SUPPORT OF PETITION FOR WRIT OF CERTIORARI

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Respondent is the world's largest manufacturer of shoe soles. Its Brief in Opposition to the Petition for Writ of Certiorari attempts by understatement and misleading contentions to belittle the significance of the Questions Presented so as to mask respondent's piratical and predatory design to appropriate Hack's invention and thereby eliminate plaintiff and its licensee as a competitor. That such is respondent's objective is an inescapable conclusion from its recent conduct in adopting its "Magic Tread" sole,—a sole identical in all respects to Hack's commercial sole.* In view of the above, respondent obviously has its tongue in

*See Appellant's Motion for Leave to File Petition for Reconsideration of Plaintiff-Appellant's Petition for Rehearing, filed June 25, 1962.

its cheek in representing to this Court that the lower Court's findings that "The patented soles had none of the advantages claimed for it" are correct.

Respondent further attempts to represent that the issues are only factual and that there are no substantial questions of law presented. In doing so, the respondent repeatedly refers to the District Court's findings of fact and their affirmance by the Court of Appeals, but ignores the fact that the ultimate findings of invalidity of the Hack patent, both for lack of invention and as anticipated by Lacoste, insofar as they are factual are based upon erroneous rules of law that are in conflict with the patent statutes and with the applicable decisions of this Court and of the other Courts of Appeal.

The Finding of Lack of Invention Is Based upon the Erroneous View that the Law Requires the Advantages of an Invention to Be Present to a Particular Extent or Degree in Order to Be Patentable

In holding the Hack patent invalid for lack of invention because of the Court's personal views that the Hack sole does not have "the advantages claimed for it to *any appreciable extent*", the Courts below have read into the patent statutes a novel requirement for a degree or extent of usefulness or utility that is not there and that is contrary to the established law. The utility in question contributed by Hack is the new result of forward propulsion as asserted in the patent and not merely the fact that the Hack sole, like any other shoe sole, keeps the wearer's bare foot from touching the ground, as respondent would have this Court believe. Of course, Hack's sole has utility in that respect, but the novel utility upon which patentability is predicated is the forward propulsion action of the Hack

sole, a function not achieved by any prior art shoe sole or even recognized in the prior art.

The District Court recognized that the Hack sole does provide forward propulsion in actual walking (R. 10) to a measurable extent per step. The decisions below, however, proceeded upon the erroneous premise that the law requires that such new result or function must be present to a greater degree than was shown by the evidence produced by both parties at the trial. This is clearly borne out by the District Court's Opinion, wherein, after inexplicably finding that the Hack structure does *not produce any* of the advantages claimed for it, the Court stated:

> "It does not appear that it *substantially* increases the wearer's stride." (Emphasis added.)

The Court of Appeals, recognizing that the evidence indisputably showed that the Hack sole achieves some forward propulsion, qualified the District Court's conclusion in this respect by stating that the District Court did not find

> "that the Hack structure produced the advantages claimed for it *to any appreciable extent*." (Emphasis added.)

Thus the findings below that the Hack sole does not *substantially* increase the wearer's stride or produce its claimed advantages to any *appreciable* extent are a tacit recognition that, if such advantages were present to a greater degree or, to use the Court's own terminology, to an appreciable extent, the patent would not have been invalidated on such ground. What the Court would recognize as an "appreciable extent" it does not say. It is therefore clear that the question of the extent or degree of utility was a controlling consideration in the view of both the District Court and the Court of Appeals, although nowhere does either Court refer to any standard by which

the requirement of utility may be measured, nor any statute or prior decision or reason that supports the Courts' conclusion that the advantages were not present to a sufficient extent to meet the statutory requirement of utility.

Thus the District Court did not hold the patent invalid for lack of invention for failing to meet the conditions for patentability set forth in 35 U.S.C. 102, or the obviousness test set forth in Section 103. The finding of lack of invention therefore must be based upon the Courts' erroneous view that 35 U.S.C. 101 or some other section of the statute requires some undefined minimum amount of utility or usefulness before a patent can be sustained. Respondent points to no such requirement in Section 101 or in any other section of the statute. Since Hack's invention admittedly provides its claimed advantage of forward propulsion, then its validity should be determined on the basis of the prior art and not on the basis of the Court's personal view of the usefulness of the invention. It should be noted that this is not a case where "forward propulsion" soles are in the prior art and Hack merely increased the amount of forward propulsion, but rather it is a case where Hack is the first to provide the phenomenon of forward propulsion in a shoe sole. Under these conditions there is no basis either in the patent statutes or in the case law for characterizing such a new and beneficial result as not useful *enough* to warrant patent protection. Since utility is a requirement for patentable invention (35 U.S.C. 101), respondent's contention that this case has nothing to do with the question of utility is erroneous and misleading.

In support of its assertion that no novel issues of law were decided in the courts below, respondent points to the fact that the District Court cited only a single case, and that on the question of commercial success. We submit that the failure of both the District Court and the Court of

Appeals, as well as respondent, to cite any prior decision or precedent in support of the conclusion that the Hack patent is invalid because it doesn't produce a *substantial* increase in stride length or doesn't produce its claimed advantages to any *appreciable* extent, is more logically explained by recognizing that *there is no precedent* for such a novel rule of law and that the decisions below are therefore contrary to the established law on this point.

The Finding That There Is No Advantage to Be Obtained from the Patented Sole Is Unsupported and the Evidence Is to the Contrary

The advantage of the patented sole as compared with prior art soles is that, because the forward propulsion adds from one-half to one inch to each step, a person will save some forty to sixty steps per mile without any greater expenditure of energy. Since the forward propulsion occurs while the sole is in contact with the ground, there is no distortion of the normal stride and no greater expenditure of energy, and the reference to Morehouse's testimony on page 7 of respondent's brief is therefore misleading. The energy saving resulting from forward propulsion is a self-evident and inherent advantage of the patented sole, and the District Court therefore placed an unwarranted burden of proof on plaintiff in requiring quantitative tests showing the extent of the energy saving before crediting the patented sole with any advantage. After recognizing that the Hack sole does provide forward propulsion, and with a clear understanding of the fact that forward propulsion occurs while the sole is in contact with the ground and therefore does not require any increase or distortion in a person's normal stride, the District Court should have recognized this phenomenon as an advantage because it will obviously result in a saving of energy in walking a

given distance as compared with conventional shoe soles. Contrary to the statement on page 6 of respondent's brief, the plaintiff's expert did not discredit the claim of energy saving but merely stated that he had not performed sufficient tests to arrive at any definite conclusions as to the extent of the energy saving.

By its failure to recognize the inherent advantage obtained by the forward propulsion action of the Hack sole, the District Court placed a burden of proof on the plaintiff which is not warranted by but is in fact in conflict with 35 U.S.C. 282.

The Finding of Anticipation of the Hack Patent by the French Patent to Lacoste Is Based Upon a Modification of Lacoste That Is Contrary to the Established Law Relating to Use of a Foreign Patent as a Reference

Respondent's brief does not even question the petitioner's contention advanced in the Petition that, in order to find anticipation by Lacoste, the District Court had to substantially reconstruct the saw cut wooden sole of the Lacoste patent. The statement on page 10 of respondent's brief that "there was substantial testimony by witnesses on both sides" concerning the Lacoste patent, followed by the citation of some 113 pages of the record, is false and misleading. Defendant's expert Woodcock did not even discuss the Lacoste patent except on cross examination in which he first erroneously stated that the Lacoste patent says that the soles could be made of leather or rubber (R. 366) and subsequently agreed that the Lacoste patent contemplates the use of wood for the saw cut soles (R. 369). The physical exhibits DDD and EEE that Woodcock testified about were not specimens of the shoe sole disclosed and described in the Lacoste patent. The only testimony in the

record about the Lacoste patent was that of plaintiff's expert Fishleigh, who testified without contradiction that the projections on the wooden saw cut sole shown in the Lacoste patent are very definitely different both structurally and operationally from the ribs of the Hack patent (R. 397). There was no testimony that the saw cut wooden soles disclosed by Lacoste would provide the forward propulsion achieved by Hack. In any event, no amount of testimony could alter the plain disclosure of Lacoste, and nowhere in such disclosure is there any teaching of placing the saw cuts in a rubber sole or any teaching of the concept of forward propulsion. The finding of anticipation by Lacoste is therefore based upon the District Court's erroneous conclusion that it was proper to reconstruct the reference in a manner not suggested in the reference or otherwise in order to find such anticipation. This is clearly in conflict with the established law on the use of a foreign reference as set forth in the Petition, and few, if any, patents could withstand such a hindsight reconstruction of the prior art.

Findings of Fact May Be Set Aside by This Court When They Are Based Upon an Erroneous Rule of Law

While the petitioner disagrees with many of the findings of fact made by the District Court and affirmed by the Court of Appeals, this Court is asked to review this case primarily because the District Court based material fact findings upon erroneous rules of law that are in conflict with the patent statutes and the established case law. The respondent relies upon *Graver v. Linde*, 336 U.S. 271, in support of the rule that concurrent findings of fact by the courts below should not be set aside except under unusual circumstances. However, the rule announced in *Graver v.*

Linde was said by Mr. Justice Douglas in his concurrence in *A & P v. Supermarket*, 340 U.S. 147, to have no place in patent law and that, having served its purpose in *Graver v. Linde*, the rule was in substance rejected in *A & P v. Supermarket*, where this Court set aside a finding of fact which it found "cannot stand as a matter of law."

While the Hack patent is of great importance not only to the present litigants and to the entire shoe sole industry in view of the great volume of pending litigation in which the patent is involved, this case presents issues of great importance to the public and the patent law since the rules of law announced by the First Circuit Court of Appeals in arriving at its decision are in direct conflict with the patent statutes and the established case law and without just cause deny the benefit of the patent laws to a meritorious patentable invention.

The Hack patent, when tested by the appropriate standard of invention to be applied to a patent which provides a new function or result never before achieved in the art, clearly meets the statutory requirements of invention and also the test of invention set forth in *A & P v. Supermarket*. The *A & P* case shows that this Court will review a patent case when the decision below has applied a less exacting standard of invention than is required in deciding the question of validity of a combination patent made up entirely of old elements with no change in their respective function. It is equally important to the public and the patent law that the lower Federal Courts do not apply a far more exacting standard of invention than is legally justified in determining the question of validity of a combination patent in which old elements, due to a new relationship and form, perform a novel function and achieve a new and beneficial result never before achieved in the prior

art. The writ of certiorari should be granted in this case in order to resolve the conflict between the law applied in the First Circuit and the other Circuit Courts of Appeal.

Respectfully submitted,

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